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OFFICE OF PETITIONS

In re Application of
Erlander, et al.
Application No. 10/062,857
Filed: October 25, 2001
Attorney Docket No. 485772002900
For: NUCLEIC ACID AMPLIFICATION

ON PETITION

This is a decision on the petition, filed December 1, 2003 (certificate of mailing date November 25, 2003), under 37 CFR 1.137(f), which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application. Petitioner also requests waiver of the revival fee under 37 CFR 1.183.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.183 is **DISMISSED**.

35 U.S.C. § 122(b)(2)(B) states:

(I) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (I).

(ii) An applicant may rescind a request made under clause (I) at any time.

(iii) An applicant who has made a request under clause (I) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (I), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

37 CFR 1.213 implements the provisions of 35 U.S.C. § 122(b)(2)(B).

Most patent applications filed on or after November 29, 2000 will be published, unless applicant files a request for nonpublication in compliance with 37 CFR 1.213(a). A nonpublication request is required to contain a certification that "the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement that requires publication at eighteen months after filing."

Petitioner filed a nonpublication request in the instant application on October 25, 2001. On December 21, 2001, a Patent Cooperation Treaty application, Application No. PCT/US01/50340, was filed. A review of the contents of the file of the above-identified application shows that no

notification of the filing of the PCT application was filed within 45 days after the filing date of the PCT application. As a result of petitioner's failure to provide timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), the above-identified application became abandoned midnight February 4, 2002 pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the Office of a foreign filing must be accompanied by:

- (1) notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

See 37 CFR 1.137(b) and (f).

Regarding petitioner's request to waive the petition fee, petitioner is reminded that the rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on the filing of each petition. See 35 USC 41(a)(7). 35 U.S.C. 41 (a)(7) provides that a petition for the revival of an unintentionally abandoned application must be accompanied by the petition fee set forth in 37 U.S.C. 1.17(m). The word "shall" appears in 35 U.S.C. 41 (a)(7) pertaining to the applicant's payment of a petition fee on the filing of a petition for revival. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. V. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). The payment of the statutory fee is obligatory upon the applicant and collection of the statutory fee is likewise obligatory upon the Office. Boyden v. Commissioner of Patents, 441 F.2d 1041, 1043, 168 USPQ 680, 681 (D.C. Cir.), *cert denied* 404 U.S. 842, 868, 171 USPQ 312 (1971); see also Giuliani v. U.S., 8 USPQ2d 1095 (D. Hi. 1988), *aff'd mem.*, 878 F. 2d 1444 (Fed. Cor. 1989). The Office has no discretion to proceed in the absence of such payment. Boyden, supra. Thus, the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived.

Therefore, the petition under 37 CFR 1.183 to waive the petition fee is **dismissed**.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). The application will be revived because the delay in providing the notice was unintentional. Revival on the basis of unavoidable delay is not provided for by the statute. Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed. The petition under 37 CFR 1.137(b) is **granted**.

This application is being forwarded to Technology Center Art Unit 1600.

Any inquiries concerning this decision may be directed to the undersigned at (703) 308-6712.



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